REMARKS

I. Claim Amendments

Originally filed claims 1, 13, 17-20, 24, and 25, and new claims 26-77, will be pending upon entry of this amendment.

Claim 17 has been amended to depend from new claim 26.

Claims 2-12, 14-16, and 21-23 have been canceled in favor of new claims 26-77 in order to more fully claim the subject matter of Group II. Applicants submit that the subject matter of new claims 26-77 falls within the scope of Group II, as defined by the Examiner in the Office Action dated February 6, 2002. New claims 26-77 find support in the claims and throughout the specification as originally filed.

More particularly, support for new claims 26-77 is found, for example, in the specification at page 10, paragraph 4 through page 11, paragraph 1; page 17, paragraph 5; page 34, paragraph 2 through page 35 paragraph 2; page 91, paragraph 3 through page 93, paragraph 1; and page 85, paragraph 1; original claim 15. Thus, no new matter has been added.

II. The Restriction Requirement.

Claims 2-12, 14-16, and 21-23 have been canceled without prejudice.

The Examiner has required an election under 35 U.S.C. § 121 of one of ten groups cast by the Examiner. The Examiner contends that the individual groupings are distinct, each from each other.

Preliminarily, Applicants point out that new claims 26-77 fall within the ambit of Group II as cast by the Examiner.

In order to be fully responsive, Applicants hereby provisionally elect, *with traverse*, the invention of Group II, drawn to polypeptides, represented by new claims 26-77.

With respect to the Examiner's division of the invention into ten groups and the reasons stated therefor, Applicants respectfully traverse.

Applicants point out that even where patentably distinct inventions appear in a single application, restriction remains improper unless the examiner can show that the

search and examination of these groups would entail a "serious burden". (*See* M.P.E.P. § 803.) In the present situation, the Examiner has failed to make such a showing.

Applicants submit that a search of polynucleotide claims of the invention would provide useful information for examining claims directed to both polynucleotides and the polypeptides encoded by these polynucleotides. In certain claims this is especially true because the polynucleotide sequence of these claims is defined in part by the polypeptide that the polynucleotide sequence encodes. Further, Applicants point out that, in many if not most publications, where a published nucleotide sequence is an open reading frame, the authors also include, as a matter of routine, the deduced amino acid sequence of the encoded polypeptide.

Similarly, a search of the polypeptide claims of the invention would clearly provide useful information for the examination of claims directed to antibodies either produced in response to or having affinity for the subject polypeptides. This is because antibodies are frequently defined by the antigens that they are produced in response to and the epitopes to which they bind. Moreover, in many publications where an antibody is described, the antigen that it was produced in response to is also described.

Further, searches of publications directed to polynucleotides and the use of those polynucleotides would clearly be overlapping. This is so because in many, if not most, publications which describe polynucleotides, these molecules are described by their function, characterization and/or expression profile. Thus, a search of polynucleotide claims would also provide the Examiner with art directed to the manner in which the claimed polynucleotides could be used in diagnostic and therapeutic indications.

Further, searches of publications directed to polypeptides and the use of those polypeptides would clearly be overlapping. This is so because in many, if not most, publications which describe polypeptides, these molecules are described by their function. Thus, a search of polypeptide claims would also provide the Examiner with art directed to the manner in which the claimed polypeptides could be used to treat disease states.

In view of the above, Applicants submit that the searches for polynucleotides, polypeptides, and antibodies; as well as methods of diagnosing, preventing and treating disease states using the nucleic acids and proteins of the subject invention; and methods of identifying a binding partner to a polypeptide of the subject invention; and methods of screening molecules which modify polypeptides of the subject invention would clearly be

overlapping. Accordingly, Applicants request that the Examiner reconsider and withdraw the restriction requirement and examine the subject matter of Groups I-IX together in the present application.

Moreover, should the Restriction Requirement be made final, Applicants respectfully request that upon indication of allowable subject matter, the Examiner rejoin the claims of Group II with Group VII.

Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

CONCLUSION

Applicants respectfully request that the above-made amendments and remarks be entered and made of record in the file history of the instant application. If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 that is not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

Date: March 6, 2002

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KKH/JS
Enclosures

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Wei et al.

Application Serial No.: 09/726,348 — Group Art Unit: 1647

Filed: December 1, 2000 — Examiner: Spector, Lorraine

Title: Transforming Growth Factor Alpha HIII — Atty. Docket No. PF220P1

VERSION WITH MARKINGS TO SHOW CHANGES MADE

Commissioner for Patents
Washington, D.C. 20231

Sir:

AMENDMENTS TO THE CLAIMS

17. (Amended) A method for preventing, treating, or ameliorating a medical condition which comprises administering to a mammalian subject a therapeutically effective amount of the polypeptide of claim [11] 26 [or of the polynucleotide of claim 1].